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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/766,934  
Filing Date: January 22, 2001  
Appellant(s): WRIGHT, CARL A.

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John G.Posa  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/17/2007 appealing from the Office action mailed 3/15/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No.2006-1123 for the same application 09/766,934 on which a decision was mailed on May 16,2006. The appeal was affirmed in part.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on 9/17/2007 with the Appeal Brief has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,493,685	ENSEL et al	12-2002
20030140316	LAKRITZ	07-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims: The ground(s) for rejection are reproduced below from the Final Office Action mailed on 3/15/2007 and are provided here for the convenience of both the Appellant and the Board of Patent Appeals:

Quote: "

***Response to Arguments***

4. In response to applicant's arguments that the support for claim 32 is in the originally filed claim 12 rejection of claim 32 under 35 U.S.C. 112, first paragraph is withdrawn.

Applicant's arguments filed 1/19/2007 concerning prior art rejection of claims 24 and 32 have been fully considered but they are not persuasive for the following reasons:

The applicant argues (see pages 1-2) that Ensel does not disclose software objects operative to either access an outside source, another object, or create a new object for acquiring and processing data for providing customized bills. Objects, as understood by examiners, are codes which can be directly executed by a system's central processing. Ensel discloses that his invention uses object oriented databases (see col.4, lines 36-38. The database files 205-230 which include data and files: Enrolment file 205 containing enrollment data, Summary file 210 containing customer's information, E-Bill file 215

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containing both current and historical data related to E-bills, Template file 220 containing data related to format electronic bills, Payment file 225 containing data related to payments and Inquiry File 230 containing data related to customer and biller inquiries are all object oriented and data is stored as objects (see Fig.5 and col.10, line 3-col.11, line 5) allowing customized generation of bills according to the biller or industry specific. In this regard, the BPAI interpretation in the Board decision mailed on 5/16/2006 for the instant application, is also persuasive and relevant (see page 6) that in Ensel "the data used for bill contents are stored as objects in an object oriented file indicates that the objects are instantiated, i.e. created or generated, when invoked",..... Applications "plug-ins" residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution. We note that such plug-ins require an application programming interface that provides protocols that must be invoked by software that is structured as objects, whether by that name or another, further evidencing the generation of objects to collect data pertinent to the client and the bill format." Further, Ensel teaches that IIP acquires and accesses billing data from outside sources such as from the accounting system of the Biller and the data which is stored as objects can be instantiated, i.e. created or generated when invoked (see at least col.4, lines 17-38 and col.6, lines 32-50).

The applicant further argues (see page 2) that Ensel does not teach "repetitively invoking the software objects ....until all the objects have completed the data acquisition and processing actions required to generate the customized bill format". The examiner disagrees because Ensel's system, that is IIP, in order to generate, format and present the bills to customers accesses and acquires all the billing data needed to publish and present the bills to customers and this will require repetitively invoking the different objects stored in different files 205-230, that is Enrollment file 205, Summary file 210, E-bill file 215, template file 220, payment file 225 and Inquiry file 230.

The applicant further argues (see pages 2-3) that in Ensel "Content is not generated" but it is received from the billers. The examiner does not agree because Ensel does generate the billing data after receiving the raw data from billers into the final presentation format as per the preference of the billers (see at least col.4, lines 17-38 and col.6, lines 32-50 and col.10, line 3-col.11, line 5).

With reference to claim 32, the applicant alleges that the examiner has used hindsight in combining the combined arts of Ensel and Lakritz to claim the applicant's invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the examiner has used only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

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In view of the foregoing the rejection of claims 24-29 and 32 is sustainable as presented in the previous office action.

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. 9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 24, Ensel discloses a method of providing customized billing services, comprising the steps of:

providing a plurality of software objects, at least certain of which are capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof; configuring a subset of the software objects to generate customized bill content for a particular bill recipient; repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content; and producing a bill by formatting the customized bill content for the particular bill recipient See at least the following segments:

col.6, lines 43-50, ***"As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel of distribution particular to a specific customer 80 receiving the presented bill or other information.***

col.4, lines 17-39, ***" ..... In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP. Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP "***, and also Figs.2, 5, and

col.10, line 3-col.14, line 5 ***"FIG. 2 illustrates an overview of structure of the elements of the present invention as well as the processing and data flow. Element 200 illustrates the structure of the Biller Acquisition Platform (BAP). The central feature of the design of the BAP 200 is that it is a database driven system. The BAP 200 includes a database server 202 having, for example, six database including an Enrollment file 205; a Bill Summary file 210; an E-Bill file 215 containing both current and historical data related to E-Bills; a Template file 200 containing the templates required to format electronic bills for the various channels of distribution 310-320; ..... a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month,***

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**exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . . ); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . . ); bill format preferences (e.g., send me summary only, partial details, full details . . . ); reminder preferences ..... The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location (address) of the bill destination, account balance, current amount due, amount past due, and minimum due. The E-Bill file 215 contains data related to the customer's current E-Bills along with historical E-Bill data which is retained for a certain period of time. The E-Bill data residing in this file 215 contains the detailed description of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller). In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects. The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented to its customers 80. Alternatively, each biller can custom format the entire look and feel of its bill.....",**

col.12, lines 12-18 and lines 31-42, " if the biller 5 desires to maintain electronic data for all of its customers 80, in anticipation of the customers 80 eventually signing up for electronic bill presentment. In such a case, the IIP 20 is able to immediately present an electronic bill to the previous paper customer 80. .... Element 245 is a reformatting processor which reformats the legacy billing data from the biller 5 in the appropriate format for inclusion on the database server 202. The billing data for the electronic bills is passed from the splitter 255 to the reformatting processor 245 ... The details of the formatting by reformatting processor 245 varies from biller to biller and is driven by the format of the billing data provided by the biller. The reformatting processor 245 feeds the Summary data file 210 and the E-Bill database 215 with the data as described above with respect to each of these databases 210, 215. ", and

Col.13, lines 27-62, "With respect to the Summary 210 and E-Bill 215 data files, BAP system 200 is capable of performing the following functions: storing a predetermined amount (e.g., thirteen months) of bill data history for each biller 5; accepting manual entry/update of bill data and producing an audit trail; receiving, editing and uploading legacy billing data files from biller 5; sending and receiving summary data; producing audit trails of all addition, change, and delete activity on files 210 and 215; extracting, reformatting, and transmitting billing data files; performing custom analysis of bill data and producing reports; and providing expandability for anticipated growth of bill and non-bill data (e.g., marketing inserts 60). With respect to the marketing inserts 60 contained in file 235, the BAP 200 can: receive and store a predetermined amount (e.g., thirteen months) of insert history; receive, store and execute the logic required for developing and executing the conditional targeting associated with the marketing inserts 60; track a wide variety of access statistics (e.g., number read by customers 80, number responded to, types of customers 80 who responded . . . ); online processing of responses from customers 80 (e.g., "I want to buy that luggage, please debit my account and send it to . . . "); and certification that an insert was read (for regulatory purposes among others). ... Armed with all of the above, the BAP 200 is capable of creating an electronic bill. How the electronic bill is formulated (in an email, as an HTML page . . . ) and where it is delivered (to an email address, to a presentment site . . . ) will be governed by the customers' 80 enrollment data contained in database 205. **Application 'plug-ins' residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution."**

Note: The above segments disclose that the sets of data used for bill contents are stored as a plurality of software objects, that is a subset of objects, in an object oriented E-bill file 215. This indicates that the subset of objects required for to provide bill contents for a particular bill recipient are

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instantiated, i.e. created or generated whenever invoked and in order to generate a plurality of data, such as *presentment configuration data (e.g., Email address, Email system/protocol, browser type and version. . . )*; *bill format preferences (e.g., send me summary only, partial details, full details . . . )*; *reminder preferences . . . . . The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller*", will require repetitive invoking of the plurality of software objects. The object-oriented E-Bill file 215 receives the data from several databases/servers and billers.

Regarding claim 25, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53).

Regarding claims 26-27, Ensel, does show that the collected data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into different portions of the bill (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information ).

Regarding claim 28, Ensel discloses that the method of claim 24, further comprising the steps of generating separate images from the collected data and correlating the separate images to at least two specific fields (see at least col.10, line 21-col.14, line 53 which discloses generating bills for different bills to customers. For different billers for the same customer two different bills/ bill images would be generated from the collected data and the two different bills would correlate to at least two specific fields such as biller's name, customer's account number, customer's name, account balance, etc.).

Regarding claim 29, Ensel discloses that the method of claim 28, wherein the separate images further comprises summary information and detailed information. (see at least col.10, lines 50, "*The structure and content of the **Summary file 210** and the **E-Bill file 215** varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location. . . . . The E-Bill data residing in this file 215 contains the **detailed description** of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller).* ". The information in summary file 210 and file 215 corresponds to the claimed summary information and detailed information which are included in the bill to be presented to the customer, see col.13, line 52-col.14, line 8).

#### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1 Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Lakritz ( US Publication 2003/0140316).

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Regarding claim 32, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Lakritz discloses this limitation of selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the intended recipient (see at least the "Abstract", Figs 2,3,5,7,10,12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125). In view of Lakritz, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the document or a bill and converting all correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide a convenient way to produce and provide documents including bills in the target language of the recipient of the document, as explicitly demonstrated in Lakritz.

7 *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

Unquote:

## **(10) Response to Argument**

### **A. Rejection of claims 24-29**

Applicant's arguments are directed to independent claim 24 and so shall the examiner's response would be directed.

The applicant argues, see AB, page 3, lines 1-19 that Ensel "has no mechanisms for invoking objects to actually acquire the data itself" and further that the objects of Ensel et al. are not capable of performing the functions set forth and claimed by the applicant and are not operative to either access an outside source, another object, or create a new object. The Examiner respectfully disagrees. Ensel discloses that his invention uses object oriented databases (see col.4, lines 36-38. The database files



205-230 which include data and files: Enrolment file 205 containing enrollment data, Summary file 210 containing customer's information, E-Bill file 215 containing both current and historical data related to E-bills, Template file 220 containing data related to format electronic bills, Payment file 225 containing data related to payments and Inquiry File 230 containing data related to customer and biller inquiries are all object oriented and data is stored as objects (see Fig.5 and col.10, line 3-col.11, line 5) allowing customized generation of bills according to the biller or industry specific. In this regard, the BPAI interpretation in the Board decision mailed on 5/16/2006 for the instant application, is also persuasive and relevant (see page 6) that in Ensel " the data used for bill contents are stored as objects in an object oriented file indicates that the objects are instantiated, i.e. created or generated, when invoked",..... Applications "plug-ins" residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution. We note that such plug-ins require an application programming interface that provides protocols that must be invoked by software that is structured as objects, whether by that name or another, further evidencing the generation of objects to collect data pertinent to the client and the bill format." Further, Ensel teaches that IIP acquires and accesses billing data from outside sources such as from the accounting system of the Biller and the data which is stored as objects can be instantiated, i.e. created or generated when invoked (see at least col.4, lines 17-38 and col.6, lines 32-50). In Ensel's system, that is IIP, in order to

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generate, format and present the bills to customers accesses and acquires all the billing data needed to publish and present the bills to customers and this will require repetitively invoking the different objects stored in different files 205-230, that is Enrollment file 205, Summary file 210, E-bill file 215, template file 220, payment file 225 and Inquiry file 230. The bills generated and formatted correspond to the generated customized bill content. Ensel does generate the customized billing data/content after receiving the raw data from billers into the final presentation format as per the preference of the billers (see at least col.4, lines 17-38 and col.6, lines 32-50 and col.10, line 3-col.11, line 5).

The applicant further argues (see AB, page 3, line 20-page 4, line 12) that Ensel does not teach “ repetitively invoking the software objects ....until all the objects have completed the data acquisition and processing actions required to generate the customized bill content” and further argues that in Ensel “ Content is not generated “ but it is received from the billers. The examiner disagrees because Ensel’s system, that is IIP, in order to generate, format and present the bills to customers accesses and acquires all the billing data needed to publish and present the bills to customers and this will require repetitively invoking the different objects stored in different files 205-230, that is Enrollment file 205, Summary file 210, E-bill file 215, template file 220, payment file 225 and Inquiry file 230. The bills generated and formatted correspond to the generated customized bill content. Ensel does generate the customized billing data/content after receiving the raw data from billers into the final presentation format as

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per the preference of the billers (see at least col.4, lines 17-38 and col.6, lines 32-50 and col.10, line 3-col.11, line 5).

In view of the foregoing, the independent claim 24 and therefore its dependencies are anticipated by Ensel's disclosure.

**B. Rejection of claim 32**

The applicant alleges that the Examiner has used hindsight in view of the applicant's disclosure to combine the teachings of Ensel and Lakritz because Ensel does not include no teaching or suggestion to combine the teachings of Lakritz that is selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the intended recipient (see at least the "Abstract ", Figs 2,3,5,7,10,.12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125). The examiner disagrees because:

(a) Lakritz explicitly discloses at or before the time of the applicant's invention, see paragraphs 0002-0010 the need and existing art of providing multilingual Web sites for converting data from one language to another language as desired by the consumer.

(b) The combination of relevant teachings of references is likely to be obvious if, *all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention*", See KSR judgment. It is also to be noted that KSR forecloses the argument that a **specific** teaching, suggestion, or

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motivation is required to support a finding of obvious ness. See the recent board decision *Ex parte Smith*,--USPQ2d, slip Op. at 20, (Bd.Pat.App. & Interf. June 25, 2007 (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>). In the instant case, one of an ordinary skilled in the art would have combined the prior known teachings of Lakritz , that is selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the intended recipient (see at least the "Abstract ", Figs 2,3,5,7,10,.12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125) with those of Ensel and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

(c) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, it was well within the objective reach of one of an ordinary skilled in the art to have combined the prior known teachings of Lakritz , that is selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the

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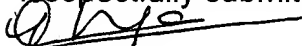
intended recipient (see at least the "Abstract ", Figs 2,3,5,7,10,.12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125) with those of Ensel because, as explicitly disclosed in Lakritz at or before the time of the applicant's invention (see paragraphs 0002-0010) there was a need and also existing art of providing multilingual Web sites for converting data from one language to another language as desired by the consumer.

**(11) Related Proceeding(s) Appendix**

Copy of the Board decision identified in paragraph (2) above is provided herein.

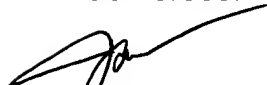
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Yogesh C. Garg  
Primary Examiner

Conferees:



Jeffrey Smith  
SPE AU3625



Vincent Millin  
Conference Specialist Tech Center 3600

The opinion in support of the decision being entered today was **not** written for publication in  
and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** CARL A. WRIGHT

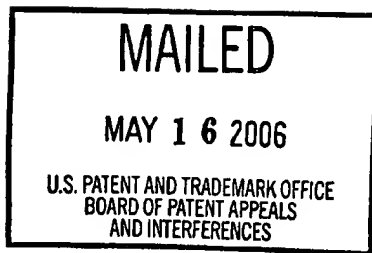
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Appeal No. 2006-1123  
Application No. 09/766,934

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ON BRIEF

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Before BAHR, NAPPI, and FETTING, **Administrative Patent Judges.**

FETTING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1-4, 12 and 14-20, which are all of the claims pending in this application.

We AFFIRM IN PART.

## **BACKGROUND**

The appellant's invention relates to automated production of sales invoices individually customized according to preferences of a client. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for providing particularized billing services, the method comprising the steps of:

selecting a client for whom a bill is to be produced, and performing the following operations within a local, expanded, or global computing environment;

extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client;

invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format; and

producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is are:

Ensel et al. (Ensel)	6,493,685	Dec. 10, 2002
Mitra et al. (Mitra)	US 2001/0014878	Aug. 16, 2001
Logan et al. (Logan)	US 2001/0009002	Jul. 19, 2001
Siemens (European Patent Document)	EP 590332	Apr. 6, 1994

Claim 12 stands rejected under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement.

Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (mailed July 13, 2005) for the examiner's reasoning in support of the rejection, and to appellant's brief (filed April 6, 2005) for the appellant's arguments thereagainst.

#### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claim 12 stands rejected under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement

Appellant presents no argument rebutting the examiner's rejection, but merely asserts that "Appellant respectfully disagrees."

In the absence of any evidence or specific argument proffered by the Appellant that claim 12 is properly enabled, we must sustain the rejection.

The rejection of claim 12 under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement is sustained.



Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel

Claims 1-4 and 16-20 are argued collectively as a group by Appellant and accordingly we select independent claim 1 as a representative claim and will address Appellant's arguments for this group to claim 1.

Appellant argues that Ensel does not teach or suggest the creation of bill content.  
(See brief at page 3 and again on page 4.)

Ensel states in col. 13, lines 27-53:

With respect to the Summary 210 and E-Bill 215 data files, BAP system 200 is capable of performing the following functions: storing a predetermined amount (e.g., thirteen months) of bill data history for each biller 5; accepting manual entry/update of bill data and producing an audit trail; **receiving, editing and uploading legacy billing data files from biller 5; sending and receiving summary data; producing audit trails of all addition, change, and delete activity on files 210 and 215; extracting, reformatting, and transmitting billing data files; performing custom analysis of bill data and producing reports; and providing expandability for anticipated growth of bill and non-bill data (e.g., marketing inserts 60).** With respect to the marketing inserts 60 contained in file 235, the BAP 200 can: receive and store a predetermined amount (e.g., thirteen months) of insert history; receive, store and execute the logic required for developing and executing the conditional targeting associated with the marketing inserts 60; track a wide variety of access statistics (e.g., number read by customers 80, number responded to, types of customers 80 who responded . . . ); online processing of responses from customers 80 (e.g., "I want to buy that luggage, please debit my account and send it to . . . "); and certification that an insert was read (for regulatory purposes among others). **Armed with all of the above, the BAP 200 is capable of creating an electronic bill.** (Emphasis added).

We note that these activities necessarily embrace the creation of bill content.  
Therefore we conclude that Ensel does teach the creation of bill content.

Appellant argues that Ensel does not teach or suggest the customer specific formatting of bills. (See brief at page 4) .

Ensel states in col. 6, lines 43-50:

As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel of distribution particular to a specific customer 80 receiving the presented bill or other information.

Although Appellant acknowledges this teaching, Appellant characterizes it as formatting specific to a channel and not to a customer.

In response, we initially note that the word “customer” is absent from claim 1. Claim 1 refers to a client instead. Appellant indicates in the arguments that the claimed client is a customer, but no such definition is apparent from the disclosure. Further, in Ensel, both the biller and the customer are clients of the intermediary service taught and claimed in Ensel. We note that claim 1 is sufficiently broad to encompass either of Ensel’s clients. Further, to the extent the customer in Ensel designates a channel, and Ensel teaches formats specific to each channel, among other formatting options, the customer is designating a format specific to that customer, albeit perhaps indirectly via the channel selection. Beyond that, Ensel teaches customer specific bill formatting provided by the data representing:

a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . . )); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . . ); bill format preferences (e.g., send me summary only, partial details, full details . . . ); reminder preferences . (Ensel, col. 10, l. 27-37).

We note that these represent instances of customer specific bill formatting.

For all of the above reasons, we conclude that Ensel does teach client specific bill formatting as claimed, and customer specific formatting as argued, but not claimed.

Appellant argues that Ensel does not teach or suggest the creation of objects.

(See brief at page 5).

Ensel states in col. 10, lines 51-65:

The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file **210** are the customer's name, account number, location (address) of the bill destination, account balance, current amount due, amount past due, and minimum due. The E-Bill file **215** contains data related to the customer's current E-Bills along with historical E-Bill data which is retained for a certain period of time. The E-Bill data residing in this file **215** contains the detailed description of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller). **In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects.**

We note that the fact that the data used for bill contents are stored as objects in an object oriented file indicates that the objects are instantiated, i.e. created or generated, when invoked. Further evidence of this is reflected at Ensel col. 13, lines 57-62:

Application 'plug-ins' residing on application server **240** accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill **215** and Summary **210** files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution.

We note that such plug-ins require an application programming interface that provides protocols that must be invoked by software that is structured as objects, whether by that name or another, further evidencing the generation of objects to collect data pertinent to the client and the bill format.

We therefore conclude that Ensel does incorporate the object generation claimed in claim 1.

Given that Ensel therefore teaches an incorporation of the elements of claim 1 in a billing structure, we must sustain the rejection, and the decision that Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel is affirmed.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens

Appellant argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the translation facility of Siemens. (See brief at page 6) .

While the examiner indicates that the rejection is based on Ensel in view of the Siemens patent (Answer, pages 4 and 7), the examiner merely points to teachings in the English language Derwent abstract of Siemens and does not provide an English language translation of the entire document as instructed in the Manual of Patent Examination Procedure section 706.02 (II) entitled "Reliance Upon Abstracts and Foreign Language Documents In Support of a Rejection" and section 1207.02 entitled "Contents of the Examiner's Answer." The teachings specifically alluded to by the examiner are directed broadly to simplification of communications between countries and provide no teaching or suggestion of the translation of correlated data to a selected language prior to generating the bill in a billing system. We make no determination as to whether such teaching or suggestion may be found in the Siemens patent itself as that was not the basis of the examiner's rejection.

Therefore, we find that the examiner has not established a *prima facie* case of obviousness of dependent claim 12. Accordingly, the rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens is not sustained and the decision that claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens is reversed.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al

Appellant further argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the teachings of Mitra. (See brief at page 6 and 7) .

We agree with the examiner that the billing system of Mitra complements the billing system of Ensel leading one of ordinary skill in the art to Mitra. But that is almost beside the point because the rejection does not attempt to combine Mitra's system with Ensel's. Rather, the teaching in Mitra is relied upon as evidence for the unremarkable showing that some bills of the types Ensel would prepare would be final, and may need to be identified as such. Any art in the field of billing services that generically taught the proposition that some bills are final and are identified as such would be equally persuasive as evidence that such bills tend to occur.

Accordingly we must sustain the rejection, and the decision that Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al. is affirmed.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al

Appellant further argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the teachings of Logan. (See brief at page 7).

We agree with the examiner that the billing system of Logan complements the billing system of Ensel leading one of ordinary skill in the art to Logan. But that is almost beside the point because, as with Mitra and claim 14 above, the rejection does not attempt to combine Logan's system with Ensel's. Rather, the teaching in Logan is relied upon as evidence for the unremarkable showing that some bills of the types Ensel would prepare would be duplicate, and may need to be identified as such. Any art in the field of billing services that generically taught the proposition that some bills are duplicate and are identified as such would be equally persuasive as evidence that such bills tend to occur.

Accordingly we must sustain the rejection, and the decision that Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al. is affirmed.

### CONCLUSION

To summarize:

The decision of the examiner to reject claim 12 as being unpatentable under 35 U.S.C. § 112, first paragraph, for lack of enablement, is **affirmed**.

The decision of the examiner to reject claims 1-4 and 16-20 under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel is **affirmed**.

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The decision of the examiner to reject claim 12 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Siemens is **reversed**.

The decision of the examiner to reject claim 14 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Mitra e al. is **affirmed**.

The decision of the examiner to reject claim 15 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Logan et al. is **affirmed**.

**AFFIRMED IN PART**

  
JENNIFER D. BAHR  
Administrative Patent Judge

  
ROBERT E. NAPPI  
Administrative Patent Judge

  
ANTON W. FETTING  
Administrative Patent Judge

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Appeal No. 2006-1123  
Application No. 09/766,934

Gifford, Krass, Groh, Sprinkle & Citkowski, P.C.  
P.O. Box 7021  
Troy, MI 48007-7021